

United States. Circuit Court. District of Connecticut.

In Equity, No. 1092 on Patents 656,556 & 655,557

VICTOR TALKING MACHINE COMPANY, Complainant

versus

AMERICAN GRAPHOPHONE COMPANY, Defendant

RECORD, 1902 - 1906.

No 1092.
U.S. Circuit Court
Dist. of Conn.

Reordered Vol. 21, P. 589.

Victor Talking Mac-
ine Company

vs.

American Grapho-
phone Company

Bill of Complaint.

Filed June 14, 1902
E. E. Marvin
Clark

Dismissed without
Prejudice.
July 20, 1906.

HORACE PETTIT,
ATTORNEY AT LAW,
STEPHEN GIRARD BUILDING, PHILADELPHIA, PA.

LAW OFFICES
HORACE PETTIT
STEPHEN GIRARD BUILDING
PHILADELPHIA

CIRCUIT COURT OF THE UNITED STATES

District of Connecticut.

In Equity.

Victor Talking Machine Company,
Complainant,

vs.

American Graphophone Company
Defendant.

To the Honorable Judges of the Circuit Court of the United States for the District of Connecticut:-

The Victor Talking Machine Company, a corporation duly organized and existing under the laws of the State of New Jersey, and having its principal office in the City of Camden, State of New Jersey, brings this its Bill of Complaint against the American Graphophone Company, a corporation organized and existing under the laws of the State of West Virginia, and having an office, factory and regular and established place of business in the City of Bridgeport, State of Connecticut, and doing business in said City of Bridgeport, within the District of Connecticut.

And thereupon your orator complains and says:

1. That Eldridge R. Johnson, formerly of the City of Camden, State of New Jersey, now a resident of the City of

Philadelphia, State of Pennsylvania, was the original, sole and first inventor of certain new and useful Improvements in Sound Recording and Reproducing Machines, which improvements were not known or used by others in this country before his invention thereof, and were not patented nor described in any printed publication in this or any foreign country before his invention thereof, and were not in public use or on sale in the United States for more than two years prior to his application for a patent therefor, and which had not been abandoned.

2. Your orator further shows unto your Honors that the said Eldridge R.Johnson being as aforesaid, the first inventor and discoverer of the said new and useful Improvements in Sound Recording and Reproducing Machines, did on the first day of June, 1897, duly make application to the honorable Commissioner of Patents at Washington, D.C., for Letters Patent of the United States for the said invention, and on the said date filed his said application with the said Honorable Commissioner of Patents in due and proper form, and thereafter duly and fully prosecuted said application.

3. Your orator further shows unto your Honors that the said Eldridge R.Johnson being as aforesaid, the first inventor and discoverer of the said new and useful improvements, did on the twenty-third day of August, 1898, file with the Honorable Commissioner of Patents, at Washington, D.C., a divisional application, being a division of the said application duly filed June 1, 1897, for the improvements in Sound Recording and Reproducing Machines, and on the said date fil-

ed his said application with the said Commissioner of Patents in due and proper form, and thereafter duly and fully prosecuted the said applications; the said original application filed June 1, 1897, bearing the Serial No. 639,028 and the said divisional application filed August 23, 1898, bearing the Serial No. 689,291.

4. Your orator further shows that upon the said application Serial No. 639,028 of Eldridge R. Johnson, Letters Patent of the United States were issued in the name of the said Eldridge R. Johnson, assignor by mesne assignments, hereafter recited, of a one-half interest to Thomas S. Parvin, of the City of Philadelphia, State of Pennsylvania, in due form of law, and in the name of the United States of America, under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Acting Commisssioner of Patents of the United States, and duly delivered, bearing date the seventh day of August, 1900, and numbered 655,556 whereby there was granted and secured to the said Eldridge R. Johnson, assignor of the one-half interest to the said Thomas S. Parvin, their legal representatives and assigns, for the term of seventeen years from the date of the said Letters Patent, and within the United States and its Territories, the full and exclusive right and liberty of making, constructing, using and vending the said invention and improvements, as set forth in the said letters patent, a duly certified copy of which is ready in court to be produced, and by virtue whereof the said Eldridge R. Johnson, and Thomas S. Parvin, his assignee of a one-half interest by deed of assign-

ment, hereinafter recited, became the sole owners of all rights and privileges granted and secured by the said Letters Patent, and of all rights in the premises.

5. Your orator further shows that upon the said application Serial No. 689,291 of Eldridge R. Johnson, being a divisional application of the said application Serial No. 639,028, filed June 1, 1897, Letters Patent of the United States were issued in the name of the said Eldridge R. Johnson, in due form of law, in the name of the United States of America and under the seal of the Patent Office of the United States, signed by the Secretary of the Interior, and countersigned by the Acting Commissioner of Patents of the United States, and duly delivered, bearing date the seventh day of August, 1900, and numbered 655,557, whereby there was granted and secured to the said Johnson, his legal representatives and assigns for the term of seventeen years, from the date of the said Letters Patent and within the United States and its territories, the full and exclusive right and liberty of making, constructing, using and vending the said invention and improvements as set forth in the said Letters Patent, a duly certified copy of which is ready here in court to be produced, and by virtue whereof the said Johnson became the sole owner of all rights and privileges granted and secured by the said Letters Patent, and of all rights in the premises.

6. Your orator further shows that on and prior to the eighteenth day of August, 1897, the said Johnson being then the sole and exclusive owner of the said invention and of

all rights to Letters Patent thereafter to be issued therefor, did, during the pendency of the said application, Serial No. 639,028, by instrument in writing duly executed, dated August 18th, 1897, recorded in the Patent Office, at Washington, D.C., in Liber , p. , etc., of Transfers of Patents, duly assign, transfer and set over unto Alfred Corning Clark, then of the City of New York, State of New York, his legal representatives and assigns, a one undivided one-half interest in and to the said inventions described and claimed in the said application for letters patent, Serial No. 639,028, filed June 1, 1897, and a one undivided one-half interest in and to all Letters Patent which should thereafter be granted therefor, as by reference to the said instrument, or a duly authenticated copy thereof, in court to be produced will more fully and at large appear.

7. And your orator further shows that Eldridge R. Johnson, and the said Alfred Corning Clark, being then the sole and exclusive owners of the said improvements in sound recording and reproducing machine as set forth in the said application for Letters Patent, Serial No. 639,028, filed June 1, 1897, each being the owner in equal shares, the said Alfred Corning Clark, during the pendency of the said application, by instrument in writing duly executed the eleventh day of November, 1897, and recorded in the Patent Office at Washington, D.C., in Liber G, 58, p. 38 of Transfers of Patents, did assign, sell, transfer and set over unto Thomas S. Parvin, of the city of Philadelphia, State of Pennsylvania, his legal representative and assigns, his one undivided one-half interest and all the entire right, title and interest of the said Clark in and to the said inventions and Letters Patent to be issued therefor as by reference to the said instrument, or a duly authenticated copy thereof in court to be produced will more fully and

at large appear.

8. Your orator further shows that the said Eldridge R. Johnson, and the said Thomas S. Parvin, being then the sole and exclusive owners of the said improvements in sound recording and reproducing machines as set forth in the said application for letters patent, Serial No. 639,028, filed June 1, 1897, and of Letters Patent No. 655,556, issued August 7, 1900, for the said invention upon the said application, each being the owner of equal shares, and letters patent of the United States No. 655,557 having been duly issued to Eldridge R. Johnson August 7, 1900 (for which the divisional application was duly filed August 23, 1898, Serial No. 689,291), the said Thomas S. Parvin, by instrument in writing duly executed the twentieth day of September, 1900, and recorded in the Patent Office, at Washington, D.C., in Liber , p. , etc., of Transfers of Patents, did assign, sell, transfer and set over unto the said Johnson all the said undivided one-half interest of the said Parvin and all his entire right, title and interest in and to the said inventions and in and to the said Letters Patent No 655,556, and any and all interest which he had or may have had in and to Letters Patent No. 655,557, and in and to any and all Letters Patent for the said inventions, and all rights of action and interest therein whatsoever which the said Parvin had by reason of any and all infringements or violations of the said Letters Patent or of his interest therein and thereto pertaining, as by reference to the said instrument, or a duly authenticated copy thereof, in court to be produced will more fully and at large appear.

9. Your orator further shows that the said Eldridge R. Johnson, being then the sole and exclusive owner of said Pat-

ent No.655,556 and No.655,557 and of the said improvements in Sound Recording and Reproducing Machines described and claimed in each of said patents by instrument in writing , duly executed the 5th day of October 1901, and Recorded in the Patent Office at Washington,D.C. in Liber K,65,page 2,of the Transfers of Patents,did assign,sell,transfer and set over unto your orator,The Victor Talking Machine Company , all his entire right,title and interest in and to said inventions, and each of them, and in and to each of the said Letters Patent No.655,556 and No.655,557, and in and to any and all Letters Patent for said inventions, and all rights of action and interest therein whatsoever which he, the said Johnson had by reason of any and all infringements or violations of said Letters Patent,or either of them,or thereto pertaining.

That by instrument in writing dated the 31st day of May,A.D.,1902, recorded in the said Patent Office in Washington,D.C., in Liber ,page ,etc. of the Transfers of Patents, the said Eldridge R.Johnson, confirmed the said assignment of October 5th,1901, above noted unto the said Victor Talking Machine Company. All of which,by reference to said instruments,or a duly authenticated copy thereof, in Court to be produced,will more fully and at large appear.

10. And you orator further shows unto your Honors,that by virtue of the premises your orator is now the sole and exclusive owner of the said Letters Patent No.655,556 and No.655,557, and of all rights of action thereto pertaining, as will more fully and at large appear by reference to the said assignments, agreements and proofs in court to be produced.

11. And your orator further shows unto your Honors that it and its predecessors in title have expended large sums of money in practicing said inventions and improvements patented in the said Letters Patent No.655,556 and No.655,557, and in introducing the same into public use, and the same are of great commercial value and practical utility; that a great public interest has been manifested therein, and a large demand created for apparatus constructed in accordance with, or embodying the same, which demand your orator is ready and able to supply; that the public generally in all parts of the United States, have recognized and acquiesced in the facts that the said Eldridge R. Johnson was the first and original inventor of the said inventions, and that the patents No.655,556 and No.655,557, are good and valid; that the public have also acknowledged the claims of your orator to the exclusive rights of the said inventions under the said patents; and that, but for the infringements and wrongs hereinafter complained of, your orator would be now in peaceful possession and enjoyment of the said Letters Patent and inventions, and of the income derivable therefrom; and that your orator and the former or sole owners in title have never acquiesced in any infringement of their rights in the premises at any time.

12. Yet, as your orator is informed and believes, and further shows unto your Honors, the American Graphophone Company, the said defendant herein named, well knowing all the facts herein set forth, but contriving to injure your orator and to deprive it of the benefits and advantages which might and otherwise would, accrue to it from the said patented devices, methods and things, has made, sold and used, and is now

making and selling and using, apparatus and things relative to sound recording or reproducing, having and containing the devices and things patented in said Letters Patent No. 655556 and No. 655,557, and employing methods covered by said Letters Patent, or in all substantial respects the same; the exclusive right to make, use and vend the same to others to use is legally vested in your orator.

13. And your orator further shows unto your Honors that notwithstanding the facts that the said defendant has been duly notified by your orator of your orator's rights in the premises, and of the fact that the said defendant was infringing the said Letters Patent of your orator, and that the said defendant should desist from such infringements, the said defendant has continued, and is still continuing, to the great and irreparable damage and injury of your orator, the manufacture, sale and use of the said infringing devices and things.

14. And your orator further shows, that it and its predecessors in title have each given notice to the public that the said inventions are patented and have affixed, or caused to be affixed, to all apparatus and devices manufactured and sold under the authority of your orator and its predecessors in title the word "Patented", together with the day and year of the grant of the said patents, of which notice the said defendant has had full knowledge.

15. And so it is, may it please your Honors, that the said defendant, as your orator is informed and believes, without the license of your orator, or of its predecessors in title, and without any license whatsoever, against the will of

your orator, and in violation of its rights, has made and sold, and intends to continue to make and sell, within the District of Connecticut and elsewhere within the United States, said patented devices and things, each having and containing the said patented features, substantially the same in all material respects in construction, operation and effect, as in your orator's said letters patent mentioned; and employing methods covered by said letters patent; and that the said defendant is largely advertising said infringements, to the great damage and injury of your orator, and that the said defendant refuses to pay unto your orator any of the profits which the said defendant has made by such unlawful manufacture and sale, or to desist from the further infringement of the said letters patent though requested so to do; all of which acts and doings are in violation of the exclusive rights and privileges, so as aforesaid, vested in your orator under and by virtue of the said letters patent; are contrary to equity and good conscience, tend to the manifest injury of your orator in the premises, and will, if said defendant is allowed to continue said infringements irreparably damage and injure your orator, depreciate or destroy the value of the exclusive franchises to which your orator is entitled under the patent aforesaid, and will deprive your orator of the benefits and advantages for the loss of which there exists no adequate legal remedy.

And your orator, therefore prays as follows:

I. That the said defendant be required by decree of this honorable court to account for and pay over to your orator such gains and profits as have accrued or arisen, or

been earned or received by the said defendant, and all such gains and profits as would have accrued to your orator and its predecessors in title but for the unlawful doings of said defendant, and all damages your orator and its predecessors in title have sustained thereby.

II. That said defendant may be compelled by the order of this honorable court to deliver up to the judicial custody for destruction in manner to be provided for in said order, all infringing apparatus in the possession of, or under the control of said defendant.

III. That the said defendant, its associates, attorneys, servants, clerks, agents and workmen, may be perpetually enjoined and restrained, by a writ of injunction issuing out of and under the seal of this honorable court, from directly or indirectly, making or causing to be made, using or causing to be used, selling or causing to be sold, any machine, method or apparatus embodying or constructed or operated in accordance with the inventions or improvements set forth in the letters patent aforesaid.

IV. That your Honors will grant unto your orator a preliminary injunction issuing out of and under the seal of this honorable court, enjoining and restraining the said defendant, its associates, servants, clerks, agents and workmen, to the same purport, tenor and effect as hereinbefore prayed for with regard to said perpetual injunction; and

V. That this defendant be decreed to pay the costs of this suit; and

VI. That your orator may have such other and further relief as the equity of the case may require.

To the end, therefore, that the defendant may, if it can show why your orator should not have the relief prayed, and may full, true and direct answer make, - but not under oath, answer under oath being expressly waived, - according to the best and utmost of its knowledge, information, remembrance and belief, to the several matters hereinbefore averred and set forth, as fully and particularly as if the same were repeated paragraph by paragraph, and said defendant thereto specifically interrogated, may it please your Honors to grant your orator a writ of subpoena ad respondendum, issuing out of and under the seal of this honorable court, directed to said defendant, the American Graphophone Company, commanding it to appear, and make answer to this bill of complaint, and to perform and abide by such order and decree herein as to this court may seem just.

And your orator will ever pray.

Victor Talking Machine Co.
by Eldridge R. Johnson
President.

Stone Peets
C. E. Mitchell
Of Counsel for Complainant.

*Mitchell Bartlett & Monrow
Complaint Solicitors*

State of Pennsylvania,)
)ss:
City and County of Philadelphia.)

Eldridge R. Johnson, being duly sworn, deposes and says that he is the President of the Victor Talking Machine Company, the complainant named in the foregoing bill; that he has read the same, and knows the contents thereof, and that the same is true of his own knowledge, save of the matters therein stated to be alleged upon information and belief, and that as to those matters he believes it to be true.

Eldridge R. Johnson

Sworn and subscribed before me this seventh day of June, A.D., 1902.

John Brady
NOTARY PUBLIC

Commission Expires at the end of the
next session of the Senate in 1903.

1881, showing general description
of subject matter to which this record
group relates. It also contains a brief history
of the records, their origin, and a list of their
contents. It includes a list of names contained in the
records, including addresses of persons, names of their head
offices and the principal offices, and the name of the
person or organization responsible for the records.

It is recommended that the records be used in conjunction with the

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Additional Information United

States Circuit Court for
the District of Connecticut

No. 1092

U. S. CIRCUIT COURT,

Dist. of Conn.

VICTOR TALKING MACHINE CO.

vs.

AMERICAN GRAPHOPHONE CO.

In Equity.

A N S W E R .

ELISHA K. CAMP,

Solicitor for Defendant,

277 B'way, New York City.

Filed Nov. 6. 1902.

P. C. Marvin
Alerc

IN THE CIRCUIT COURT OF THE UNITED STATES
For the District of Connecticut.

VICTOR TALKING MACHINE CO.

vs.

AMERICAN GRAPHOPHONE CO.

In Equity.

On Johnson patents
No. 655,556, and
655, 557.

The answer of the AMERICAN GRAPHOPHONE COMPANY,
defendant, to the bill of complaint of the VICTOR TALKING
MACHINE COMPANY.

This defendant answering the said complainant's
said bill of complaint, says:

This defendant admits that it is a corporation
organized and existing under the laws of the State of West
Virginia and doing business in and having a regular and
established place of business in the City of Bridgeport within
the said District of Connecticut. And this defendant further
admits that the complainant VICTOR TALKING MACHINE COMPANY
is a New Jersey corporation having its principal office in
Camden, N. J.

1.

This defendant, in answer to paragraph 1. of
the said Bill of Complaint, denies that the said ELDRIDGE
R. JOHNSON invented improvements in Sound Recording and
Reproducing Machines as alleged in said Bill; and denies
that the same involved an inventive act, or that the said
Johnson was the original or the first or the sole inventor
or producer thereof; and denies that the same were either
new or useful at the date of his alleged invention; and denies
that the same were--or any part thereof was--patentable,
affirming that the same were and was merely an aggregation of

old and well known elements operating in an old and well known manner; and this defendant further denies that the said alleged improvements were not known or used by others in this country before the alleged invention thereof by the said Johnson, or had not been patented or described in any printed publication in this or any foreign country before his alleged invention thereof; and denies that the said alleged improvements were not in public use or on sale in this country for more than two years prior to the date of his application for the grant of U. S. Letters-patent therefor, or that the same had not been abandoned.

2.

As to the matters and things alleged in paragraph 2. of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as it can.

3.

As to the matters and things alleged in paragraph 3. of the bill, this defendant has no information, save from said bill, and therefore leaves complainant to make such proof thereof as it can.

4.

This defendant admits that there issued on the 7th day of August, 1900, Letters-patent of the United States purporting to be granted to Eldridge R. Johnson and Thomas S. Parvin, bearing the number 655,556, and purporting to be for Improvements in Sound Recording and Reproducing Machines; however, this defendant is not advised save by the bill as to the remaining allegations in the said paragraph contained, and therefore leaves the complainant to make such proof thereof as it can; but this defendant expressly denies that by virtue of the premises the said Eldridge R. Johnson and Thomas S.

Parvin became the sole owners of all rights and privileges granted and secured by the said Letters-patent and of all the rights in the premises, or of any rights and privileges whatever.

5.

This defendant admits that there was issued on the 7th day of August, 1900, Letters-patent of the United States purporting to be granted to Eldridge R. Johnson, bearing the number 655,557, and purporting to be for Improvements in Sound Recording and Reproducing Machines; however, this defendant is not advised save by the bill as to the remaining allegations in the said paragraph contained, and therefore leaves the complainant to make such proof thereof as it can; but this defendant expressly denies that by virtue of the premises the said Eldridge R. Johnson, or any one, became the sole owner of all rights and privileges granted and secured by the said Letters-patent and of all rights in the premises, or of any rights and privileges whatever.

6.

As to the matters and things alleged in paragraph 6. of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as it can.

7.

As to the matters and things alleged in paragraph 7 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as it can.

8.

As to the matters and things alleged in paragraph 8 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as it can.

As to the matters and things alleged in paragraph 9 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as it can.

As to the allegations in paragraph 10 of the bill, touching complainant's title to the patents in suit, this defendant has no information save from the said bill, and therefore leaves complainant to make such proof thereof as it can; but this defendant again denies that by virtue of the premises the complainant, or any one, has the exclusive right or any rights in the premises.

In answer to the allegations in paragraph 11 of the bill, this defendant is not informed, save by said bill, that the complainant or any one ever spent large sums of money or any sums of money in practicing said alleged inventions or improvements purporting to be patented in and by the said Letters-patent No. 655,556 and No. 655,557, and in introducing the same into public use; and this defendant denies that the same or any substantial or material part thereof are or ever were of great commercial value or practical utility or of any value or utility whatever; and denies that a great public interest or any interest has been manifested therein, or that a large demand or that any demand has been created for any apparatus constructed in accordance with or embodying the alleged improvements or any of them; and as to what apparatus the complainant is ready and able to supply, this defendant is not advised save by the said bill of complaint, but upon information and belief avers that numerous suits in equity have been filed against this complainant, ^{and its predecessors} seek

ing to enjoin ~~him from~~ the manufacture and sale of talking-machines and talking-machine supplies; and this defendant further denies that the public generally, or any one, has ever recognized and acquiesced in the facts that the said Johnson was the first and original and sole inventor of the said alleged inventions and that the said patents or either of them were or are good and valid, or that the public or any one has also acknowledged the claims of this complainant to any rights under the said patents; and this defendant further denies that save for the alleged infringements and wrongs by the said bill charged to be committed by this defendant, the complainant would be in peaceful enjoyment and possession of the said Letters-patent and of whatever income might be derivable therefrom, and that the owners of the said Letters-patent had never acquiesced in any alleged infringement of their alleged rights in the premises,—but in this regard this defendant shows upon information and belief that all persons familiar with the talking-machine art or engaged in the talking-machine business have long known that there is nothing novel or useful in the matters and things purporting to be covered by the claims of the said Letters-patent, or by any claim thereof, and they have regarded with ridicule any claim on the part of the said Johnson or of this complainant to invention therein.

12.

And in answer to paragraph 12 of the said bill, this defendant admits that it has manufactured talking-machines and appliances therefor relative to sound-recording and reproducing; but this defendant expressly denies that any one of such articles ever had or contained or now has or contains any device or thing patented, or purporting to be patented, in and by any claim or claims of said Letters-patent No. 655,556,

or of said Letters-patent No. 655,557; and this defendant further denies that any claim of either of said patents covers or purports to cover any "method" as intimated by the said paragraph 12; and this defendant denies that it ever contrived to injure this complainant or to deprive it of any benefits and advantages which might accrue to it from the said patents or from any other source; and this defendant again denies that by virtue of the premises ~~the~~ exclusive rights or any rights have ever become vested in this complainant.

13.

And this defendant expressly and positively denies each and every allegation in paragraph 13 of the said bill contained.

14.

In answer to paragraph 14, this defendant has no information save by the bill as to any notice given to the public by the complainant or its predecessors, or as to any article being by it or ~~them~~ or by their authority marked together with the date of the grant of any patent, and "patented," therefore leaves the complainant to make such proof thereof as it can; but this defendant expressly denies any knowledge of the said alleged notice.

15.

And in answer to the allegations in paragraph 15, this defendant denies that it has ever made or sold or used any device or article or apparatus or things having or containing any feature patented to this complainant, or purporting to be patented to it, or the same in any material respect as to the articles and things purporting to be claimed in the said patents, or in either of them; and this defendant further denies that it has ever made any gains or profits to which this complainant is entitled, or that this complainant was ever damaged or injured by any act of this defendant, or

that this defendant has ever been requested by this complainant to desist from any alleged infringement; this defendant again denies that this complainant is by virtue of the premises possessed of all exclusive rights and privileges under and by virtue of the said Letters-patent, or of any rights or privileges whatever; and denies that its own actions are contrary to equity and good conscience; and denies that there is any equity whatever in complainant's said bill of complaint.

16.

And for a further defense, this defendant affirms that not one of the various matters and things and combinations disclosed by the said Letters-patent and by each of them, is or ever was the result of an inventive act; and further affirms that each and every one of the same was not novel with the said Johnson, but on the contrary was well known in this country long before the alleged invention thereof by him, and had been in public use in this country for more than two years before the date of his application; and that the claims in each of the said patents contained are for aggregations of old and well known features; and affirms that the same are no~~t~~now and were never capable of any useful employment whatever, but on the contrary are and were inoperative.

17.

And for a further defense this defendant shows, and the same is manifest from a comparision of the said Letters-patent here sued on with the original applications and the proceedings thereon in the Patent Office, that the alleged improvements and inventions purporting to be covered by the claims of the said patents are substantially and materially different from those originally disclosed by the application and applications as originally filed; and the defendant,

again insisting that there is no novelty whatever in any of the matters and things claimed in and by the said patents, affirms that if there be any novelty at all in the claims as allowed the same is found in the new matter thus unlawfully and unwarrantably introduced into the said applications during their pendency in the Patent Office; and that therefore the said patents are void and of no effect in law.

18.

And for a further defense this defendant avers that its sole business is as a manufacturing concern and its manufactures are used and sold by two West Virginia corporations known as the COLUMBIA PHONOGRAPH COMPANY and the COLUMBIA PHONOGRAPH COMPANY, GENERAL; that this complainant's predecessor in title the aforesaid Eldridge R. Johnson formerly exhibited his bill of complaint against the said COLUMBIA PHONOGRAPH COMPANY, GENERAL, in the Honorable Circuit Court of the United States for the Eastern District of Pennsylvania, charging infringement by the defendant therein of the two Letters-patent here in suit, and asking for injunctions and an accounting;—the same being docketed in the said Court "In Equity, October Sessions, 1900, No. 12"; that the said COLUMBIA PHONOGRAPH COMPANY, GENERAL, duly appeared and on or about February 2, 1902, filed its Answer to the said bill of complaint; that thereafter no further steps were taken in the matter until sometime during the early part of the year 1902, the said bill of complaint was upon application of the said Eldridge R. Johnson dismissed with payment of costs to the defendant therein, but without prejudice, as by reference to the records of said court or duly authenticated copies thereof here in court to be produced will more fully and at large appear; and this defendant avers, upon information and belief, that the said suit in

the Eastern District of Pennsylvania was upon the same cause of action as that asserted in the present suit, wherefore this defendant avers that this complain^{ant} through its predecessor in title the said Johnson) has already had its day in Court and the bill of complaint herein is without equity.

19.

For a further defence this defendant avers, upon information and belief, that the said alleged inventions and each and all of them were not produced by the said Johnson alone, but were the joint product of one Alfred Corning Clark (then of Philadelphia, Pa., but now of Paris, France) together with the said Johnson; and that therefore the said patents are void and of no effect in law.

20.

For a further defence this defendant avers, upon information and belief, that the said alleged inventions and each and all of them were not produced by the said Johnson alone, but were the joint product of one -----Reinhardt (then and now of Camden, New Jersey), together with the said Johnson; and that therefore the said patents are void and of no effect in law.

21.

For a further defence this defendant shows that the matters and things purporting to be claimed by the patents in suit were fully disclosed and set forth, and were attempted to be claimed, in and by the various patents previously granted to the said Johnson, either as sole patentee or conjointly with others, before the date of the issue of the patents here in suit, to wit, in U. S. Letters-patent No. 624,625, granted May 9, 1899, to the said Alfred Corning Clark and said Johnson upon a joint application filed Jan. 9, 1897, and in other patents granted in this country and in foreign countries, the

dates and numbers of which are at present to this defendant unknown, but which it prays leave to introduce as part of this answer when ascertained; and that therefore the said patents are void and of no effect in law.

22.

And for a further defence this defendant shows that by reason of thus having fully disclosed the said inventions in his said early patent and patents without claiming the same, the said Eldrige R. Johnson thereby abandoned the inventions purporting to be covered by the patents here sued on, and the same thereby became dedicated to the public; and therefore the said patents and each of them are void and of no effect in law.

23.

And for a further defence to the said patent No. 655,557, this defendant avers that the matters and things purporting to be claimed thereby are fully disclosed in the said Letters-patent No. 655,556, and are attempted to be claimed thereby; wherefore the said Letters-patent No. 655,557 are void and of no effect in law.

24.

And for a further and special defence, this defendant shows First, that for the purpose of deceiving the public the descriptions and specifications filed in the Patent Office by the said Johnson were made to contain less than the whole truth relative to his alleged invention or discovery, or more than is necessary to produce the desired effect; and that the claims and each of them are ambiguous and insufficient, and that the specifications and each of them are not in such full, clear, concise and exact language as to enable others skilled in the art to make, construct and use the alleged improvements; and, therefore, the said patents are void and of no effect in law.

. And for a further and special defence, this defendant shows Second, that the said patents and each of them were surreptitiously and unjustly granted for that which was in fact the invention or production of another, or others, who was or were using due diligence in reducing the same to practice,- namely, the said Alfred Corning Clark, the said Reinhardt, Joseph W. Jones, of New York City, Louis P. Valiquet, of New York City, and others, whose names and addresses are ^{at present} to this defendant unknown, but which when discovered this defendant prays leave to insert in this Answer; and that therefore the said patents are void and of no effect in law.

And for a further and special defence, this defendant shows Third, that each and all of the said alleged improvements were fully set forth and disclosed in and by the following Letters-patent of the United States, that is to say:

- No. 227,679, granted May 18, 1880, to Thomas A. Edison;
- No. 341,214, granted May 4, 1886, to Bell & Tainter;
- No. 341,288, granted May 4, 1886, to Sumner Tainter;
- No. 375,579, granted Dec. 27, 1887, to Sumner Tainter;
- No. 386,974, granted July 31, 1888, to Thomas A. Edison;
- No. 393,466, granted Nov. 27, 1888, to Thomas A. Edison;
- No. 394,105, granted Dec. 4, 1888, to Thomas A. Edison;
- No. 394,106, granted Dec. 4, 1888, to Thomas A. Edison;
- No. 400,646, granted Apr. 2, 1889, to Thomas A. Edison;
- No. 409,093, granted Aug. 13, 1889, to Gianni Bettini;
- No. 409,005, granted Aug. 13, 1889, to Gianni Bettini;
- No. 415,499, granted Nov. 19, 1889, to Louis S. Clarke;
- No. 423,039, granted Mar. 11, 1890, to Thomas A. Edison;
- No. 424,914, granted Apr. 1, 1890, to John H. White;

No. 427,279, granted May 6, 1890, to Werner Suess;
No. 440,155, granted Nov. 11, 1890, to Isaac W. Haysinger;
No. 450,740, granted Apr. 21, 1891, to Thomas A. Edison;
No. 454,942, granted June 30, 1891, to Thomas A. Edison;
No. 454,947, granted June 30, 1891, to Wm. McMahon;
No. 474,410, granted May 10, 1892, to Rosenthal & Frank;
No. 500,281, granted June 27, 1893, to Thomas A. Edison;
No. 531,690, granted Jan. 1, 1895, to Stewart D. McKelvey;
No. 564,586, granted July 28, 1896, to Emile Berliner;
No. 572,182, granted Dec. 1, 1896, to Ray;
No. 601,198, granted Mar. 27, 1898, to E. R. Johnson;
No. 604,829, granted May 31, 1898, to J. W. Jones;
No. 605,484, granted June 14, 1898, to J. W. Jones;
No. 633,226, granted Sept. 19, 1899, to Adolph Betzold;
No. 634,944, granted Oct. 17, 1899, to E. R. Johnson;
No. 651,904, granted June 19, 1900, to L. P. Valiquet;
No. 652,800, granted July 3, 1900, to H. S. Montgomery;
No. 637,196, granted Nov. 14, 1899, to Emile Berliner;
and the following German patent:-
No. 82,934, granted Oct. 1, 1895, to Lahola & Sachs;
and others whose respective dates and numbers are
to this defendant now unknown, but which when ascertained
it prays leave to insert in this Answer; and therefore the
said patents are void and of no effect in law.

27.

And for a further and special defence, this defendant shows also, that each and all of the said alleged improvements were fully set forth and disclosed in and by the following printed publications, that is to say, in and by each of the Letters-patent enumerated in the foregoing paragraph of this Answer, which were issued from and may be found in the Patent Office of the United States, at Washington, D. C.; and in and by other printed publications whose respective titles, dates, and places of publication, to-

gether with the places where the same may be found, and the pagings where such reference may be located, are at present to this defendant unknown, but which it prays leave when discovered to insert in this Answer.

28.

And for a further and special defence this defendant shows Fourth, that the said Johnson was not the first to produce the alleged improvements and inventions disclosed and purporting to be covered in and by the said Letters-patent and each of them; but that the same had been both known to others and also been produced and used by them long prior to the first alleged production thereof by the said Johnson, as follows:-

By Thomas A. Edison, of and at Llewellyn Park, N. J., and elsewhere;

Chichester A. Bell, of and at Washington, D. C., and elsewhere;

Sumner Tainter, of and at Washington, D. C., and elsewhere; Emile Berliner, of and at Washington, D. C., and elsewhere; Gianni Bettini, of and at the City of New York and elsewhere;

Louis S. Clarke, of and at Pittsburg, Pa., and elsewhere; John H. White, of and at Washington, D. C., and elsewhere; Wm. McMahon, of and at Rahway, N. J., and elsewhere; Stewart D. McKelvey, of and at Canton, Ohio, and elsewhere; Adolph Betzold, of and at St. Louis, Mo., and elsewhere; Louis P. Valiquet, of and at the City of New York and elsewhere;

----- Reinhardt, of and at Camden, N. J., and elsewhere; Alfred C. Clark, of and at Philadelphia, Pa., and elsewhere, whose present address is Paris, France;

and others whose names and addresses are to this defendant now unknown, but which when ascertained it prays leave to in-

sert in this Answer, and therefore the said patents are void and of no effect in law.

29.

And for a further and special defence this defendant shows Fifth, that the matters and things and alleged combinations disclosed in and by the claims of the said Letters-patent, and each of them, had been in public use and on sale in this country for more than two years before the date the said Johnson made application for patent thereon, to wit, by each of the persons named in the preceding paragraph of this Answer, and in addition by the following:

U. S. Gramophone Co., of Washington, D. C., at that place and elsewhere;

Berliner Gramophone Co., of Philadelphia, Pa., at that place and elsewhere;

Universal Talking Machine Co., of New York City, at that place and elsewhere;

National Gramophone Co., of New York City, at that place and elsewhere;

National Gramophone Corporation, of New York City, at that place and elsewhere;

American Talking Machine Co., of New York City, at that place and elsewhere;

Albert T. Armstrong, of New York City, at that place and elsewhere;

Joseph W. Jones, of New York City, at that place and elsewhere;

and others whose names and addresses are at present unknown to this defendant but which when discovered it prays leave of this Court to insert in this Answer; and therefore the said patents are void and of no effect in law.

And for a further and special defense, this defendant shows that in view of the state of the art disclosed by the before-mentioned patents and instances of prior knowledge and public use, the alleged improvements constituting the alleged inventions of the said Johnson, were at the date of his alleged invention thereof without novelty; and for the same reasons they were without invention; and for the same reasons they were wanting in patentability; wherefore the said patents are void and of no effect in law.

And for a further defense, this defendant shows that the apparatus and things dealt in by this defendant more nearly and closely resemble certain improvements made by the afore-mentioned Louis P. Valiquet than they resemble the alleged improvements set forth in the patents here in suit; that upon information and belief, on Dec. 19, 1898, the said Valiquet filed an application for the grant of U. S. Letters-patent covering his said inventions and improvements; that the said application became involved in interference proceedings with the pending application of the said Johnson which eventuated into the patents in suit; and that on May 5, 1900, by decision of the highest Tribunal in the Patent Office, reported in Vol. 92 of the Official Gazette of the U. S. Patent Office, pp. 1795-7, it was held that the apparatus and things and combinations set forth and disclosed in and by the said application of Valiquet did not, and could not, come within the terms of the claims of the said pending Johnson application, which latter subsequently eventuated into the patents here in suit; and it was further decided in the same interference proceedings that the alleged improvements and arrangements set forth and claimed by Johnson (comprising or involving the subject-matter of the claims here in suit) consisted in supporting the diaphragm from the middle rather than from

its periphery, and in having the diaphragm free at its periphery both adjacent to the two faces of the gaskets and at its cylindrical edge,- whereas, in the description as originally filed it was expressly stated by the said Eldridge R. Johnson that the said diaphragm was supported by the said rubber gaskets, was held by them, was under tension or pressure between the said rubber gaskets, and that there was contact between the said gaskets and the diaphragm; and that there has been no appeal from the said decision in the Patent Office, nor has the same ever been reversed or set aside; for which reasons this defendant avers that the question of infringement of the patents here in suit by the defendant's apparatus is now res adjudicata which has been finally decided in the negative, and the decision acquiesced in by the said Johnson.

32.

And for a further defense this defendant, upon information and belief, avers that the apparatus and matters and things disclosed in and by patent No. 655,557, (one of the patents here in suit) and attempted to be claimed by the same, are entirely distinct and separate from the apparatus and matters and things disclosed in and by patent No. 655,556, (the other patent here in suit) and attempted to be claimed therein; that the aforesaid things described in the former are not used, and can not be used, conjointly with the matters disclosed by the latter of said patents; and that therefore the infringement of the said two patents may not be set up in one Bill of Complaint.

33.

And this defendant craves the same benefit of the matters and things hereinbefore set forth and alleged, to the same extent as if the same were specially pleaded where a plea would have been proper, or as if on account thereof it had demurred to the said Bill of Complaint (or to part or parts thereof) where a demurrer could have been proper;

LAW OFFICES
HORACE PETTIT
STEPHEN GIRARD BUILDING
PHILADELPHIA

CIRCUIT COURT OF THE UNITED STATES

District of Connecticut

In Equity.

Patents Nos. 655,556 and 655,557

Victor Talking Machine Company,
Complainant

vs.

American Graphophone Company,
Defendant.

And now to wit this 9th day of October 1902, on motion of Counsel for complainant, counsel for defendant acquiescing therein as per stipulation thereto attached, it is ORDERED that the complainant have leave to amend the Bill of Complaint filed in the above entitled cause by inserting after paragraph 10 the following paragraph:-

"10^a. And your orator further says upon information and belief that the inventions set forth and claimed in Letters Patent Numbers 655,556 and 655,557, hereinbefore mentioned, are capable of conjoint use and embodiment in a single talking machine, that your orator has so used and embodied said inventions in a single structure, that said inventions have been and are now being so conjointly used by the defendant herein, and that talking machines made and sold by said defendant, as hereinafter set forth, contain and embody the inventions covered by both said Letters Patent."

It is further ORDERED that the defendant have until
November Rule day within which to file an Answer, Plea, or
Demurrer.

Entered

By the Clerk

attah B. Marvin Clark

It is stipulated and agreed by and between counsel for
the respective parties that the demurrer heretofore filed by
the defendant be withdrawn and that the above Order allowing
the complainant to amend its Bill of Complaint be entered.

H. H. Peck,

Of Counsel for Complainant

C. F. Massie,

Of Counsel for Defendant

October 7th, 1902.

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No. 1092 Sessions, 190

UNITED STATES CIRCUIT COURT

District of Connecticut

IN EQUITY.

*Victor Talking
Machine Company*
Complainant

v.s.

American Graphophone Co.
Defendant

Order Dismissing

Bill of Complaint
Filed July 20, 1906.
C. R. Marvin
Clark

HORACE PETTIT,
ATTORNEY AT LAW,
STEPHEN GIRARD BUILDING, ✓
PHILADELPHIA, PA.

HORACE PETTIT
STEPHEN GIRARD BUILDING
PHILADELPHIA

UNITED STATES CIRCUIT COURT
District of Connecticut.

In Equity, No. 1092.

Suit on U. S. Patents, Nos. 655,556 and 655,557.

Victor Talking Machine Company,

vs.

American Graphophone Company.

And Now, To Wit, this 20th day of July, 1906,
the parties having consented thereto, as per the Consent at-
tached, it is ORDERED that the Bill of Complaint be dismissed,
without prejudice, upon the payment by the complainant of the
costs of the Clerk of the Court.

Ordered accordingly.

Hartford July 20. 1906 By the Court:

Test: P. F. Carroll, Dep. Clerk.
We consent to the entry of the above Order.

July 17, 1906.

Horne Pettit.

Of Counsel for Complainant.

Philip Lauer

Of Counsel for Defendant.

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Additional Information

*Records
of the United States Circuit*

or parts thereof) where a demurrer would have been proper; and if there be any other matter, cause or thing in this Bill of Complaint contained, necessary for this defendant to make answer unto and not herein well and sufficiently answered, confessed or avoided, traversed or denied -- this defendant says that the same is not true to its knowledge and belief; all of which matters and things this defendant is ready and willing to aver, maintain, and prove, as this Honorable Court shall direct; and it prays to be hence dismissed with its reasonable costs and charges in this behalf most wrongfully incurred.

(corporate seal)

Dated November 4, 1902.

AMERICAN GRAPHOPHONE COMPANY,

By *East* President.
By E. D. Easton, President.

PHILIP MAURO,

Philip Mauro

C. A. L. MASSIE,

C. A. L. Massie,

Of Counsel for Defendant.

ELISHA K. CAMP,

Elisha K. Camp

Solicitor for Defendant,

277 Broadway, New York City.

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Waltham, Massachusetts

No. 1093.

U. S. Circuit Court,
Dist. of Conn.

VICTOR TALKING MACHINE COMPANY

vs.

AMERICAN GRAPHOPHONE COMPANY

IN EQUITY
On Johnson Patents Nos. 655,556
and 655,557.

DEMURRER.

ELISHA K. CAMP,
Solicitor for Defendant,
277 Broadway,
New York City.

Filed Aug. 4th, 1903.

E. E. Marvin,
Clerk.
G.

IN THE CIRCUIT COURT OF THE UNITED STATES
For the District of Connecticut.

VICTOR TALKING MACHINE COMPANY

v.

AMERICAN GRAPHOPHONE COMPANY

In Equity
On Johnson Patents
No. 655,556, and
No. 655,557.

D E M U R R E R.

The demurrer of AMERICAN GRAPHOPHONE COMPANY, defendant, to the Bill of Complaint of VICTOR TALKING MACHINE COMPANY, complainant.

This defendant, by protestation, not confessing or acknowledging all or any of the matters and things and charges in the said complainant's Bill of Complaint herein to be true in such manner and form as the same are therein set forth and alleged, as to the entire Bill doth demur thereto; and for cause of demurrer sheweth:

I.

That it appears upon the face of the said Bill that this is a suit to enjoin the alleged infringement of two separate and distinct Letters-patent of the United States, to wit Nos. 655,556, and 655,557; while the said Bill does not show that the two alleged inventions are conjointly employed by this defendant in one and the same article, or that complainant so conjointly employs them, or that the two are capable of conjoint use in one and the same article.

II.

That it does appear from the said Bill that the claims of patent No. 655,557 were divided out from the application which eventuated in patent No. 655,556; that the claims of No. 655,557 could not be made in patent No. 655,556, and vice versa; and that the matters and things and combinations constituting the alleged improvements and inventions purporting to be claimed in one of these two patents cannot

be embodied in any single article which at the same time contains or embodies or employs any of the matters and things and combinations constituting the alleged improvements and inventions purporting to be claimed in the other patent, and vice versa.

III.

That it appears from the Bill that the same sets forth two separate and distinct causes of action that may not be joined in a single suit; and that the said Bill is multifarious.

Wherefore, and for divers other good causes of demurrer appearing in the said Bill of Complaint (which this defendant reserves the right to interpose and specify ore tenus), this defendant demurs to the whole of said Bill; and humbly demands the judgment of this Court whether it should be required to make any other or further answer to the same; and prays to be hence dismissed with its reasonable costs and charges in this behalf most wrongfully sustained.

Elisha K. Camp

ELISHA K. CAMP,
Solicitor for Defendant,
277 Broadway,
New York City.

CERTIFICATE.

I hereby certify that in my opinion the foregoing Demurrer is well founded in point of law and proper to be filed in the above-entitled case.

C.A.L. Massie
C.A.L. MASSIE,
of Counsel for Defendant.

AFFIDAVIT.

STATE OF NEW YORK,
County of New York, SS.:

E. D. Easton, being first duly sworn, deposes and says: I am — President of AMERICAN GRAPHOPHONE COMPANY, named as defendant herein; I have read the foregoing demurrer by the defendant corporation to the Bill of Complaint of VICTOR TALKING MACHINE CO., and the same is not interposed for the purpose of delay.

Subscribed and sworn to before me,
this 29th day of July - 1902.

(Seal)

William H. Hiles

NOTARY PUBLIC, No. 107.
NEW YORK COUNTY.

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Record Group No. 21

Additional Information Records
of the United States Circuit
Court for the District of
Connecticut.

No. 6092.

U. S. Circuit Court
Dist. of Connecticut

Victor Talking Mach-
ine Company.

vs

American Grapho-
phone Company.

Order permitting
Amendments to Bill
with withdrawal of
Demurrer etc and
Consent thereto

Filed Oct 9, 1902
C. C. Marvin
Clerk

HORACE PETTIT,
ATTORNEY AT LAW,
STEPHEN GIRARD BUILDING, PHILADELPHIA, PA.